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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,612	03/09/2001	Sami Uskela	617-010120-US	1625

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PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER

OMARY, NAWARA T

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,612

Applicant(s)

USKELA, SAMI

Examiner

Nawara T. Omary

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/09/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 1/26/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 23.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 7, 8, 12 and 13 are rejected under U.S.C. 102 (b) as being anticipated by Burke (Patent #4,737,978).

In regard to Claim 1, Burke discloses the design of an inter-system handover method of a mobile station moving and communicating via radio from one cellular network to another. Where through this handover process, a transfer of data communications occurs between the first and second calls. (Please refer to Abstract; Specifications, column 2-lines 38 through 57 and figure1).

In regard to Claims 2, 4, 12 and 13, Burke discloses the design of an inter-system handover method of a mobile station moving and communicating via radio from one cellular network to another; where through this handover process, a transfer of data communications occurs between the first and second calls, and consequently the first call gets released (Figure 5b-decision block 240). Burke further discloses that the first network generates the request for a handover (Specifications-column 12-line 17), and that both networks are cellular (Abstract-

line 1). Moreover, Burke discloses that the mobile station can communicate via radio with both networks (Summary of the Invention-line 28).

In regard to Claims 7 and 8, Burke discloses a handover method in which the first cellular network originates the call (Specifications-Column 8-lines 60-63). Where the mobile station transmits identification in second network to the first network (specifications, column 13-lines 50 to 55).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 5 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (Patent #4,737,978) ^{and ? and from} in view of Roach (Patent #5,845,211).

In regard to claims 3,5 and 6 Burke discloses a handover method where a mobile station communicates between a first and a second cellular network and a transfer of data occurs upon such communication as indicated in his specifications (Specifications, column 8, lines 24 to 60). However, Burke does not disclose a mobile station to initiate a request for a handover and to originate

a second call. Roach teaches a mobile station to initiate a request for a handover (Abstract- lines 18-20) and to originate the second call as can be seen where the transfer of data with ID takes place (Figure 8 and Specifications, column 26- lines 3-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a mobile controlled handoff in order for the mobile station to update its network with the quality of coverage it is receiving and to transfer the required data and ID information.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (Patent #4,737,978) in view of Gillig et al. (UK Patent #2,225,512).

In regard to Claim 9, Burke discloses a handover method between two cellular networks with overlapping regions of coverage as indicated in his Abstract. However, Burke does not disclose the size of coverage areas in which the second network is larger than the first network. Gillig et al. teach the amount of coverage provided by each network where the second network (cellular) has a greater region of coverage than the first network (cordless). Please refer to Figure 1. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to assign the second network to be larger in size than the first network in order to lower the likelihood of handover from the larger network to the smaller network.

6. Claims 10 and 11 are rejected 35 U.S.C. 103(a) as being unpatentable over Burke (Patent #4,737,978) in view of Korpela (Patent #6,510,146 B1).

In regard to Claims 10 and 11, Burke discloses two adjacent cellular networks as indicated in his Abstract. However, Burke does not disclose the type of such cellular networks. Korpela teaches the adjacency of second-generation digital cellular networks, such as GSM, PDC, etc to new third generation networks such as IMT-2000 and FPLMTS etc. (Introduction, column –lines 38 to 45). Such adjacency of networks is important in order to provide mobile users with the most possible uninterrupted service. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to specify the second network to be an IMT-2000 and the first network to be a PDC in order to provide subscribers with the most uninterrupted service and to provide a smooth transition from a 2G network to a 3G network.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nawara T. Omary whose telephone number is 703.305.6311. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703.308.5318. The fax phone numbers for the organization where this application or proceeding is

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**assigned are 703.872.9314 for regular communications and
7703.872.931403.746.9701 for After Final communications.**

**Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the receptionist whose telephone number is
703.306.0377.**



**WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**

July 24, 2003